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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,561	10/24/2001	James P. Donelan	112692-006	5058
24573	7590	04/07/2004	EXAMINER	
BELL, BOYD & LLOYD, LLC			FERNSTROM, KURT	
PO BOX 1135				
CHICAGO, IL 60690-1135			ART UNIT	PAPER NUMBER
			3712	

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/003,561	DONELAN, JAMES P.
<b>Examiner</b>	<b>Art Unit</b>	
Kurt Fernstrom	3712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 22 January 2004.  
2a)  This action is **FINAL**.                            2b)  This action is non-final.  
3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-3 and 6-20 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-3 and 6-20 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_

5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3 and 6-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear what is meant by the term "semi-rigid", or how the term defines the scope of the claim. The term is not defined in the specification so as to apprise one of the scope of the invention.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 9 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hare in view of Lassoff. Hare discloses in column 3, line 55 to column 5, line 45 of the specification a folder comprising a transparent flexible body having an integrally formed erasable writing surface. As a folder, it is inherently bent at one end. This fold represents a bent end capable of removably securing a sheet of paper to the body.

Column 3, lines 54-6 and column 7, lines 15-27 in particular discusses the erasable

writing characteristics of the transparent member of the folder. A user can write on both sides of the folder. Hare fails to disclose that the folder comprises a dry erase board.

Lassoff discloses in column 2, line 64 to column 3, line 14 of the specification a transparent sheet of plastic which can be used as a dry erase board. It would have been obvious to one of ordinary skill in the art to modify the device disclosed by Hare by providing a dry erase surface to the folder for the purpose of allowing a user to more easily remove markings from the sheet, without the using of cleaning chemicals. It is believed that the folder of Hare inherently comprises a semi-rigid body, because the folder inherently must be able to maintain its shape to be folded into a folder and to store an indicia bearing sheet, and because applicants' specification fails to define "semi-rigid" in some way as to clearly define some structure which is lacking in the Hare disclosure. Also, applicant discloses that its dry erase board comprises a polypropylene film or a polyethylene film, without disclosing any additional materials which would impart "semi-rigidity" to the body. Both of these materials are disclosed in column 4, lines 1-3 of Hare. To the extent that Hare fails to disclose a semi-rigid body, Lassoff discloses in column 3, lines 7-14 that its transparent dry erase sheet may be laminated to a heavier material to provide strength and body to the sheet, thus suggesting the use of a semi-rigid body to provide a stronger, more stable dry erase surface. With respect to claim 13, the sheet inserted into the device is artwork which is to be copied, and thus has indicia thereon, as discussed in particular at column 5, lines 54-65 of Hare.

Claims 3, 6-8, 10, 14, 15, 17 and 18 and are rejected under 35 U.S.C. 103(a) as being unpatentable over Hare in view of Lassoff, and further in view of Weinthrop. Hare

as viewed in combination with Lassoff discloses all of the limitations of claim 3, 6-8 and 10 with the exception of the second bent end of the body. Folders having a plurality of bent ends are well known. Weinthrop discloses in Figure 1 one such folder, wherein the body 2 comprises bent sections 12, 7 and 10, which are folded to allow the device to retain sheets of paper. It would have been obvious to one of ordinary skill in the relevant art to modify the device disclosed by Hare as viewed in combination with Lassoff by providing a plurality of bent sections to the body for the purpose of more securely retaining the sheet of paper within the device. The bent ends contact various surfaces and edges of the sheet. With respect to claims 14 and 15, Weinthrop discloses in column 1, lines 62-67 that the bending of the sections forms a pocket. With respect to claim 18, the front surface of the folder disclosed by Hare has a dry erase surface, as discussed above.

Claims 2 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hare in view of Lassoff, and further in view of Ko. Hare as viewed in combination with Lassoff discloses all of the limitations of claims 2 and 12 with the exception of the device being flat when shipped. It is known to ship folding items in an unfolded state. Ko discloses in column 1, lines 53-60 of the specification one example of folding binders which are shipped in a flat state. It would have been obvious to one of ordinary skill in the relevant art to modify the device disclosed by Hare as viewed in combination with Lassoff by providing the device in a flat state when shipping for the purpose of making the device less thick, and thus easier to ship in larger numbers.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hare in view of Lassoff, and further in view of Mogelonsky. Hare as viewed in combination with Lassoff discloses all of the limitations of claim 11 with the exception of the use of adhesive. Adhesive is a well known means of attaching elements of a folder. Mogelonsky discloses in column 7, lines 40-43 of the specification one example of a folder which comprises adhesive 29, which is used to attach members 26 and 14 to form a pocket 30. It would have been obvious to one of ordinary skill in the relevant art to modify the device disclosed by Hare as viewed in combination with Lassoff by providing adhesive for the purpose of more securely assembling the folder to retain a sheet of paper.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hare in view of Lassoff and Weinthrop, and further in view of Mogelonsky. Hare as viewed in combination with Lassoff and Weinthrop discloses all of the limitations of claim 16 with the exception of the use of adhesive to attach the pocket. Adhesive is a well known means of attaching elements of a folder. Mogelonsky discloses in column 7, lines 40-43 of the specification one example of a folder which comprises adhesive 29, which is used to attach members 26 and 14 to form a pocket 30. It would have been obvious to one of ordinary skill in the relevant art to modify the device disclosed by Hare as viewed in combination with Lassoff and Weinthrop by providing adhesive for the purpose of more securely assembling the folder to retain a sheet of paper.

Claims 19 and 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hare in view of Lassoff, and further in view of Schwartz. Hare as viewed in combination

with Lassoff discloses all of the limitations of claims 19 and 20 with the exception of the open back. Schwartz discloses in Figures 4 and 4a a folder comprising one open side, which could be the back depending on how the device is positioned. It would have been obvious to one of ordinary skill in the relevant art to modify the device disclosed by Hare as viewed in combination with Lassoff by providing a device with an open back for the purpose of providing easier access to a sheet of paper retained therein.

### ***Response to Arguments***

Applicant's arguments filed on January 22, 2004 have been fully considered but they are not persuasive.

Applicant's arguments concerning the failure of Hare to disclose a dry erase board, and the resulting problems with the rejections of claims 3, 6-8, 10-12 and 14-20, are persuasive. These rejections have been modified to include the teachings of Lassoff. Because new grounds of rejection are thus presented, the action is made non-final.

Applicant's arguments concerning the term "semi-rigid" are unpersuasive. Applicant has noted a dictionary definition of "semi-rigid". The question then becomes, to what "degree" must the body be rigid. Applicant asserts that the "flexible" material of Hare is the complete opposite of "rigid". The examiner respectfully disagrees. Firstly, the claimed invention has some degree of flexibility. If it did not, it would be rigid. The Hare device also has some degree of flexibility in certain embodiments. So, both Hare and the present invention disclose devices which are at least somewhat flexible.

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Applicant has not defined how the claimed invention is "more" rigid than the device of Hare, and has failed to indicate specific materials which impart "semi-rigidity" to the invention in such a way as to overcoming the teachings of Hare. Secondly, Hare discloses, in column 3, lines 64-65 that the folder is **preferably** flexible (emphasis added), which leaves the door open to other materials (immediately preceding that passage, Hare recites that the folder may be made of "any suitable material"). Thirdly, the teachings of Lassoff, which include lamination to impart semi-rigidity to a transparent dry erase surface, have been included in all of the rejections. Applicant has not indicated anything improper in the combination, which was previously cited in the rejections of claims 1, 9 and 13. For each of these reasons, applicant's arguments concerning the term "semi-rigid" are not persuasive.

The applicant's arguments concerning the importance of the rigidity of the material allowing the device to support or removably secure the piece of paper are also unpersuasive. Hare discloses a folder for removably securing a piece of paper therein. Many different types of folders are well known, of varying degrees of flexibility, where the folders inherently have a bent end and removably secure a piece of paper therein. Additionally, Hare discloses in column 4, lines 61-66 that crimps in the sides of the folder may be employed to secure the artwork in the folder. Hare discloses a device having a bent end capable of removably securing a piece of paper therein.

Applicant further requests that the feature of bending a dry erase semi-rigid material to create an area for receiving a sheet. As discussed above, Hare as viewed in combination with Lassoff discloses this feature. Hare discloses an erasable material

which is bent to create an area for receiving a sheet, both by its folder (which inherently has a bent end and receives a sheet of paper) and by the crimps discussed above. Lassoff discloses a dry erase surface which is laminated to impart additional semi-rigidity. The two references, viewed together, suggest this feature of applicant's invention.

The newly added amendments to the claims do not overcome the prior art because Hare discloses, in column 4, lines 15-19, that the second member of the folder "may be of the same material as the first member". Applicant has argued that this language overcomes Hare, because Hare discloses a flexible folder. This argument is unconvincing, for two reasons. Firstly, "so that a user can write" is very broad language. A user might find it inconvenient or difficult to simultaneously write on both sides of the folder of Hare, but it is still possible to do so. Secondly, Lassoff teaches imparting a semi-rigidity to a transparent dry erase surface, as discussed above. Hare, as viewed in combination with Lassoff, clearly suggests this property.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Fernstrom whose telephone number is (703) 305-0303. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (703) 308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KF  
April 2, 2004

*Kurt Fernstrom*  
Kurt Fernstrom